



MAIL STOP AF
PATENT
0540-1016

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Laurent DUMORTIER et al. Conf. 8126

Application No. 10/681,101 Group 1744

Filed October 9, 2003 Examiner L. Guidotti

DEVICE FOR REMOVING MASTIC, PARTICULARLY
FOR THE REPAIR OF JOINTS IN STRUCTURES OF
AIRCRAFT TANKS AND CONTAINER FOR USE THEREWITH

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Sir:

March 12, 2008

Applicants request a pre-appeal brief review of the final rejection in the above-identified application. No amendments are being filed with this request. A Notice of Appeal is filed herewith. The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

YOUNG & THOMPSON

Roland E. Long

Roland E. Long, Jr. Reg. No. 41,949
Attorney for the applicants
209 Madison Avenue, Suite 500
Alexandria, Virginia 22314
Telephone (703) 521-2297
Telefax (703) 685-0573
(703) 979-4709

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief review is respectfully requested because the rejections include a clear legal error, as explained below.

Applicants request review of the final rejection of Claim 1 as obvious over TOPIARZ DE 19949071 in view of LANE 5,924,204; claims 1, 6-8, and 11-13, 15-16, 18, and 20-21 over PIERCE 5,353,465 in view of JP 05-321189; claims 3, 14, 17, 19, and 22 over PIERCE 5,353,465 in view of JP 05-321189; claim 9 over PIERCE in view of JP 05-321189 and SANDT 4,137,588; and claim 10 over PIERCE in view of JP 05-321189, SANDT, and TOPIARZ.

Not All Recitations Were Considered

Each of the claims include recitations concerning a specific "hardness" that has not considered by the Examiner, e.g., claim 1 recites a tool having "a head (38) with a hardness for removing aircraft-fuel resistant aircraft mastic", and "a distal end contact portion of the head for removing the mastic is made of a non-abrasive material selected from polyetheretherketones, polyoxymethylenes, polyetherimides or epoxy resins with the hardness sufficient to cut off chips of the aircraft mastic from joints in interiors of aircraft tanks and resist wear, but not too hard so as to give rise to scratches, under the effect of vibratory

alternating movement, to the interior surface of the aircraft tanks".

In the paragraph spanning pages 7-8 of the Official Action, the Examiner expressly states that the recitations "a hardness for removing aircraft-fuel resistant aircraft mastic", "the hardness sufficient to cut off chips of the aircraft mastic from joints ..." were given no patentable weight.

The Examiner has characterized these recitations as being a material or an article worked upon, and functional in nature. This is incorrect. The recitations of the present claims, characterized as "functional", are properly directed to characterizing the structure of the invention and must therefore be given patentable weight.

Applicants are not claiming the mastic itself or the interior surface of the aircraft tanks. Rather, applicants are making reference to the mastic and the interior surface of the aircraft tanks in specifying the hardness of the head, e.g., claim 1 recites a tool having "a head (38) with a hardness for removing aircraft-fuel resistant aircraft mastic", and "a distal end contact portion of the head for removing the mastic is made of a non-abrasive material selected from polyetheretherketones, polyoxymethylenes, polyetherimides or epoxy resins with the hardness sufficient to cut off chips of the aircraft mastic from joints in interiors of aircraft tanks and resist wear, but not too hard

so as to give rise to scratches, under the effect of vibratory alternating movement, to the interior surface of the aircraft tanks".

It is a hardness that is being recited. This recited hardness must be given patentable weight.

Reference is made to MPEP 2173.05(g) "Functional Limitations [R-3]" where guidance is provided on this topic. Generally, a functional limitation defines something by what it does. The MPEP expressly states that "There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper." See *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

Indeed, the MPEP expressly states that a "functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ... to define a particular capability or purpose that is served by the recited element, ..." (emphasis added).

For example, in *Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc.*, 381 F.3d 1111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004), the court noted that the claim term "operatively connected" is "a general descriptive claim term frequently used in patent drafting to reflect a

functional relationship between claimed components," that is, the term "means the claimed components must be connected in a way to perform a designated function." Thus, "the term 'operatively connected' takes the full breath of its ordinary meaning, i.e., 'said tube [is] operatively connected to said cap' when the tube and cap are arranged in a manner capable of performing the function of filtering." Id. at 1120, 72 USPQ2d at 1008.

This MPEP section also notes that "It was held that the limitation used to define a radical on a chemical compound as 'incapable of forming a dye with said oxidizing developing agent' although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. In re Barr, 444 F.2d 588, 170 USPQ 33 (CCPA 1971)." Also, "In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as 'members adapted to be positioned' and 'portions . . . being resiliently dilatable whereby said housing may be slidably positioned' serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976)."

As applicants are not claiming the mastic itself or the interior surface of the aircraft tanks, and rather are making reference to the mastic and the interior surface of the aircraft tanks in specifying the hardness of the head, the

hardness recitations are proper and must be given patentable weight.

To not consider the hardness recitations is clear legal error and the rejections must be withdrawn.

Conclusion

As the rejections have not considered all the claim recitations, the rejections include clear legal error.

Accordingly, the rejections of record cannot be sustained and must be withdrawn; such is respectfully requested.